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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,761	10/11/2001	Kenneth C. Caster	IR-2588(ET)CIP2	1165

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EXAMINER
KNABLE, GEOFFREY L.

ART UNIT	PAPER NUMBER
1733	

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	09/975,761	CASTER ET AL.	
	Examiner	Art Unit	
	Geoffrey L. Knable	1733	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____
 Claim(s) objected to: _____
 Claim(s) rejected: _____
 Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s) _____.
 13. ☒ Other: Attachment: Interview Summary Record.


 Geoffrey L. Knable
 Primary Examiner
 Art Unit: 1733

Continuation of 5. Applicant's reply has overcome the following rejection(s): the 35 USC 112, second paragraph rejection from the last office action and the potential obviousness double patenting issues with respect to 09/711,692, it being noted that the 1-3-2005 Terminal Disclaimer with respect to 09/711,692 has been reviewed, accepted and recorded.

Continuation of 11. does NOT place the application in condition for allowance because: First, with respect to the 1.130 declaration and MPEP 718, it is noted that this rule is ONLY applicable to rejections under 35 USC 103 - e.g. note 37 CFR 1.130 (a) and thus again a 1.130 declaration has no bearing on a rejection under 35 USC 102. Second, with respect to the previously filed petition to accord the parent filing date, it is first noted that a stay/suspension is not applicable as an office action (i.e. final rejection) is outstanding - 37 CFR 1.103 and MPEP 709. Further, contrary to applicant comments, acceptance of this petition and according the parent filing date will not automatically moot the relevant rejections. In particular, even if benefit is given, this application is a continuation-in-part of the parent application and the ONLY claims that are entitled to benefit of that filing date are claims that are FULLY supported in the parent application and it is submitted that none of the claims rejected under 35 USC 103 are fully supported. These claims are therefore not entitled to benefit of the parent filing date. In fact, arguably even the claims presently rejected under 35 USC 102, although considered to be anticipated by the mixtures mentioned in the reference, are not clearly fully supported/described in the parent application as there is no clear description therein of a monomer dissolved in a principal metathesizable material as claimed. To be entitled to the benefit of the filing date of the (grand)parent application, in addition to acceptance of the petition, it must be clearly shown why all the present claims (including every limitation thereof) are described in the (grand)parent application. Further, the 1.103 declaration, although applicable to rejections under 35 USC 103, is still considered deficient for reasons set forth in the final rejection.